

**REMARKS**

In the January 24, 2006 Office Action, the Examiner noted that claims 1-5, 7, 8 and 10-22 were pending in the application; rejected claims 1-5 under the first and second paragraphs of 35 U.S.C. § 112; rejected claim 21 under 35 USC § 101; and rejected claims 1-5, 7, 8, and 10-22 under 35 USC § 103. In rejecting the claims, U.S. Patent 6,434,556 to Levin et al. (Reference A in the January 24, 2006 Office Action) was cited. Claim 21 has been canceled and claim 23 has been added. Thus, claims 1-5, 7, 8 and 10-20, 22 and 23 remain in the case. The rejections are traversed below.

**Rejections under 35 USC § 112, First Paragraph**

On pages 2-4 of the Office Action, claims 1-5 were rejected under the first paragraph of 35 USC § 112 as allegedly containing "subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, has possession of the claimed invention" (Office Action, page 2, last four lines).

In the first paragraph on page 3 of the Office Action, the Examiner asserted that a person of ordinary skill in the art would be unable to determine "the number of documents in the claimed 'collected document group'" (Office Action, page 3, lines 3-4). It is submitted that one of much less than ordinary skill in the art would be able to determine the number of documents that have been collected regardless of how the documents were collected or what term is used to refer to the set of documents. If the claims continue to be rejected for lack of support in the specification for "number of documents," the Examiner is respectfully requested to cite what would prevent anyone with even rudimentary computing skills from being able to determine how many documents have been collected.

In the second paragraph on page 3 of the Office Action, it was asserted that a person of ordinary skill in the art would not have been able to understand how to determine "referring documents from outside the community to a referenced document inside the community" (Office Action, page 3, lines 9-10). First, it is noted that the first paragraph of the Description of the Related Art Section on page 1 of the application states that the invention is related to a "retrieval engine for a document processed through a network such as Internet, WWW, etc." (application, page 1, lines 14-15). It is submitted that such an environment is well known to people of much less than ordinary skill in the art. In the next paragraph the general environment of the invention is described as "collecting documents based on a given URL (Uniform Resource Locator)

Group" (application, page 1, lines 21-22). In particular, "collecting an uncollected document referenced based on the information about the reference among documents, for example, an anchor, a hyperlink, etc." (application, page 1, line 24 to page 2, line 2). It is submitted that the use of hyperlinks by the World Wide Web and in intranets is so notoriously well-known that persons of much less than ordinary skill in the art are fully enabled without any teaching in the specification of how "referring documents ... [point to] a reference document" (Office Action, page 3, lines 9-10). The search for such documents using, e.g., a "robot, spider or crawler" (application, page 1, lines 16-17) is commonly performed by virtually all World Wide Web search engines. Therefore, it is submitted that it is unnecessary to teach one of ordinary skill in the art how to accomplish this task.

Furthermore, as to whether any particular document is or is not "inside or outside ... [a] community" (Office Action, page 3, line 8) would be fundamentally understood by one of ordinary skill in the art who has defined the community. As stated in the Description of the Related Art section of the application, a common task in the art of collecting documents involves starting with a given set of documents and searching for related documents. The specification and claims use the term "community" to refer to, e.g., "a community such as an enterprise " (page 5, lines 2-3) and an "Intranet community of an enterprise" (page 5, lines 21-22). However, one of ordinary skill in the art would understand that the term could refer to many different defined sets of documents which are the starting point of a collection of additional documents.

The third paragraph on page 3 of the Office Action asserted that one of ordinary skill in the art would be unable to make and use the invention due to a lack of "a concise description of the claimed 'reference relation'" (Office Action, page 3, line 18). It is submitted that there is no requirement in U.S. patent law for "a concise definition" for any term used in the claims. Furthermore, it is submitted that one of ordinary skill in the art would have no difficulty understanding this term even if the words "reference" and "relation" were not used in close proximity in the specification. However, in fact the words are used together in several sentences, such as on page 25, lines 3-9 with regard to "the relation of a document to a specified field such as the reference score" (page 25, lines 4-6) and the description of "parent-child/brothers relations" on page 58, including in the parenthetical following "high reference score" (page 58, line 13). As a result, it is submitted that one of ordinary skill in the art would have no difficulty in understanding the meaning of the term "reference relation" as used in the claims.

In the paragraph spanning pages 3 and 4 of the Office Action, it was stated that "[c]laim 1 includes first documents, second documents and third documents" (Office Action, page 3, line

20) despite the fact that these terms were removed from the claims in the Amendment filed with the Request for Continued Examination (RCE) filed November 14, 2005 and received by the U.S. Patent and Trademark Office November 16, 2005. According to the first paragraph on page 2 of the Office Action, the Amendment filed with the RCE "has been entered." Therefore, there should have been no rejection of the claims for the use of the terms "first documents, second documents and third documents."

For the above reasons, withdrawal of the rejections under the first paragraph of 35 USC § 112 is respectfully requested. If the Examiner does not withdraw these rejections, the Examiner is respectfully requested to contact the undersigned to arrange another Examiner Interview prior to issuing the next Office Action to discuss what further amendments of the claims are necessary to avoid another rejection of the claims as allegedly inadequately supported by the specification.

#### **Rejections under 35 USC § 112, Second Paragraph**

On page 4 of the Office Action, claims 1-5 were rejected under the second paragraph of 35 USC § 112 for "allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention" (claim 4, lines 7-8) due to an alleged lack of "antecedent basis ... [in claim 1] for 'the reference collected document group.'" These five words (which are also quoted on the preceding line of the Office Action) do not appear consecutively in claim 1. Since no line number(s) were provided in the rejection under the second paragraph of 35 USC § 112, it is unclear what the Examiner was reading when this rejection was made.

Hopefully the cleaner copy of claim 1 in this Amendment will enable the Examiner to see all of the words in claim 1. If this does not result in withdrawal of the rejection under the second paragraph of 35 USC § 112, the Examiner is respectfully requested to contact the undersigned to identify where in claim 1 the alleged indefiniteness exists.

Due to the lack of information provided in the written Office Action, it is impossible to respond to this rejection. Therefore, it is respectfully submitted that the next Office Action should not be final if claims 1-5 continue to be rejected under the second paragraph of 35 USC § 112.

#### **Rejection under 35 USC § 101**

On pages 4-5 of the Office Action, claim 21 was rejected under 35 USC § 101 as directed to non-statutory subject matter. Claim 21 has been canceled and therefore, this rejection is moot.

**Rejection under 35 USC § 103(a)**

On pages 5-9 of the Office Action, claims 1-5, 7, 8 and 10-22 were rejected under 35 USC § 103(a) as unpatentable over Levin et al. It is assumed that in making this rejection, the interpretations of the limitations which were rejected under the first paragraph of 35 USC § 112 and the decision to give no "patentable weight" (Office Action, page 4, line 12) to limitations in claim 1 resulted in citation of Levin et al. which does not include several features of the claimed invention.

For example, in the paragraph spanning pages 5 and 6 of the Office Action in the discussion of the limitations in claims 1, 16, 17, 19, 21 and 22, there was no mention that the first collecting operation performed in claim 1 is performed "until the number of documents is equal to or larger than a predetermined value" (claim 1, lines 3-4). At page 3, line 6, it was indicated that the predetermined value was being interpreted as "=1." It is submitted that regardless of the size of the "predetermined value" claim 1 requires that a determination be made that at least this number of documents have been "collected from inside a community ... based on a reference of each document in the collected document group" (claim 1, lines 4-6). Regardless of whether the predetermined value is set as described on page 29 of the application as "approximately 1/4 through 1/2 of all documents in the community" (page 29, lines 21-22), some determination must be made that a number of documents have been collected which would be sufficient for "collecting a newly collected document group from inside and outside the community" (claim 1, line 9). Nothing was cited or has been found in Levin et al. that less than all of the documents are collected from the "search result" (Office Action, page 5, line 21) that was asserted to be equivalent to the "community" (Office Action, page 5, line 21), e.g., as recited on line 5 of claim 1.

Column 9, line 60 to column 10, line 12 of Levin et al. was cited as allegedly teaching "collecting a newly collected document group from inside and outside the community" (claim 1, line 9) which inherently requires that additional documents be collected from (if Levin et al. disclosed the invention as asserted in the Office Action) the "search result" and from other documents not included in the search result. However, what is described at this portion of Levin et al. is a description of steps 220 and 230 in Fig. 4 of Levin et al. It is noted that box 140 at the top of Fig. 4 describes this drawing as "analysis of search results". Thus, if the "community" is defined as the "search result[s]" as indicated in the Office Action, then Fig. 4 including the description in columns 9 and 10 does not teach or suggest "a newly collected document group from inside **and outside** the community" (claim 1, line 9), because only documents included in

the search results are analyzed in the process illustrated in Fig. 4. Additional distinctions over Levin et al. could be noted, but since this most fundamental requirement of the invention is not taught or suggested by Levin et al., these distinctions will not be discussed.

In addition, the independent claims have been amended to recite details previously recited in claim 2. In rejecting claim 2, it was asserted that Fig. 3B disclosed the limitations previously recited in claim 2, including "indicating a level of significance of a collected document ... according to references to the collected document, and information about a position of the collected document in the network" (Office Action, page 6, lines 16-18). Claim 1, for example, has been amended to recite

indicating a level of significance of a collected document ... according to references to the collected document and information about a position of the collected document in the network, with the significance of the collected document increasing with an increased number of references to the collected documents

(claim 1, lines 11-14). While, Fig. 3B indicates that weights are assigned to various factors, there is nothing in Fig. 3B indicating how the weight is assigned, let alone teaching or suggesting the specific way of determining the significance currently recited in claim 1 with similar limitations recited in the other independent claims.

For all of the above reasons, it is submitted that the remaining claims patentably distinguish over Levin et al.

### **Summary**

It is submitted that Levin et al. does not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-5, 7, 8, and 10-20, 22 and 23 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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